

REMARKS

Claims 1-33 are pending in the present application. Claims 1-7, 16-20 and 29-33 are withdrawn based on the restriction requirement. Claims 8-15 and 21-28 have been amended. Support for the amendments can be found throughout the entire original disclosure and the original drawings. No new matter has been added and entry of the amendments is respectfully requested.

Double Patenting

The Examiner rejected claims 8-15 and 21-28 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,012,048 (hereinafter as the “’048 patent”). Applicant respectfully traverses this double patenting rejection.

First, Applicant submits that the claimed subject matter of the present patent application is not substantially the same as the claimed subject matter of the ‘048 patent.

Furthermore, in the previous Office Action mailed on October 9, 2008, the Examiner restricted the claims in the original patent application into three distinct and independent inventions (groups). The Examiner placed claims 8-15 and 21-28 in Group II which was categorized as a method and a machine for performing wire transfer of funds to a transferee. The Examiner further placed claims 1-7 in Group I which was categorized as a banking machine for performing cash transaction and claims 16-20 and 29-33 in Group III

which was categorized as a banking machine for paying bills through a bills payment network.

The Examiner stated that the groups are distinct each from another, they are related as combination and subcombination, and the combination as claimed does not require the particulars of the subcombination (see page 2 of the previous Office Action).

Thus, Applicant respectfully submits that based on the restriction requirement, the double patenting rejection should not be made. It is inconsistent for the Examiner to make the restriction requirement and now reject the claims based on double patenting.

Finally, in an effort to expedite prosecution, Applicant may consider filing the Terminal Disclaimer in a supplemental response shortly hereafter. However, Applicant does not feel that the filing of a Terminal Disclaimer is required at this time. Applicant is in the process of reviewing evidence and determine if a Declaration to swear behind one of the cited prior art is warranted. In the event that Applicant decides to file such Declaration, the Terminal Disclaimer will be filed at the same time.

However, for at least the reasons stated above, Applicant respectfully submits that this double patenting rejection should be reconsidered and withdrawn.

Claim Rejections under 35 U.S.C. § 102

The Examiner rejected claims 8, 10, 13, 14, 21, 23, 26 and 27 under 35 U.S.C. §

102(e) as being anticipated by U.S. Patent No. 5,937,396 (hereinafter as “Konya”). In particular, the Examiner asserted that, *inter alia*, the limitation of “a payment acceptor for accepting payment by the user for the wire transfer” is disclosed by Konya. To support this assertion, the Examiner alleged that “the card reader 24 of Konya is also a payment acceptor to accept the transaction card 30 for transferring the money from the user’s account to the recipient’s account.” Applicant respectfully traverses this rejection.

Konya discloses a system for ATM-to-ATM transfer. Konya discloses at best, only one payment method with account withdrawal such that Konya’s system does not disclose a cash acceptor accepting cash to be transferred or that the Konya’s card reader can be used as a payment acceptor when funds are withdrawn from the account.

However, in the claimed invention, the user can choose a payment method from among cash, credit card, smart card and account withdrawal. If the user chooses the payment method with cash, then he can deposit cash in the cash acceptor. If the user chooses the other payment methods, then he does not need to use the cash acceptor because the card receiver having a card reader will work as the payment acceptor.

Thus, the Examiner alleged that the Konya’s card reader is the same as the payment acceptor of the present invention. However, the payment acceptor is a distinguishable element different from the Konya’s card reader, because it comprises a cash acceptor, a credit card receiver and a smart card receiver, i.e., the user can choose to pay for the transfer

with cash, a credit card or a smart card. More particularly, the cash acceptor having a cash receiver is a separate element from the card receiver such that the cash acceptor cannot be taught by the Konya's card reader.

Additionally, Applicant submits that the Examiner admitted in her statements in the rejection under 35 U.S.C § 103(a), that "Konya does not disclose wherein the payment acceptor comprises a cash receiver for receiving and totaling the cash received" (See page 9, paragraph 10 of the Office Action). The Examiner further admitted that Konya does not disclose a payment acceptor comprising a credit card reader and a smart card reader (See pages 9 and 10 of the Office Action). Therefore, Applicant submits that Konya's card reader is different from the payment acceptor.

However, to expedite the patent application, to clarify the claimed invention and also for editorial purposes, Applicant has amended claim 8. With respect to claim 8, the "payment acceptor" is changed to "cash acceptor" and with respect to claim 21, the method of payment is further defined to include cash, credit card or account withdrawal.

In addition to the above-mentioned amendment, so that the claims are not unduly limited, Applicant has amended claim 8 by deleting the two limitations of "an input device to enter the amount to be transferred to another" and "a keypad to enter the identity of the transferee's account" and added them in a dependent form as new claim 34. Furthermore, Applicant has deleted the term "banking" recited in claim 8 and added this

limitation in a dependent form as claims 35 and 36 for the same purpose. Furthermore, the claims have been amended to delete the term “wire” as this term unduly limits the claimed invention. In certain claims, the term “cash” has been changed to “funds” while the term “wired” has been changed to “transferred.”

Therefore, claim 8 and new claims 34-36 should be allowed.

In addition to the above rejection based on Konya, with respect to claim 13, the Examiner alleged that a printer that prints a receipt for the sender of the transfer is taught by Konya at column 8, lines 44-50 describing a printing device which can be used to prepare a transaction report. However, claim 13 also requires “a transactional record system makes and keeps a record of the transfer.” Regarding this limitation, the Examiner did not refer to any citation in Konya. Thus, Applicant submits that this claim rejection is improper. Additionally, since Konya does not disclose anything pertaining to this limitation, claim 13 is patentably distinguishable whether or not it is dependent from claim 8.

With respect to claim 21, the Examiner rejected this claim alleging that the limitation of “providing the machine with a method of payment for the transfer” is taught by Konya since Konya discloses “the input/output section 10 include[ing] appropriate sources of input data for reading the appropriate card.” The present patent application claims a method of payment for the transfer which includes the method of payment from

among cash, credit card, smart card or account withdrawal. As the Examiner admitted in the section of claim rejections under 35 U.S.C § 103 of the Office Action, Konya does not teach, suggest or disclose anything regarding the payment method from among cash, credit card or smart card. Rather, Konya might teach, at best, the payment method with account withdrawal.

Thus, Applicant traverses this rejection by amending claim 21. Applicant has amended claim 21 by adding this limitation of “from among cash, credit card, smart card or account withdrawal” after “providing the machine with a method of payment for the transfer.” Additionally, as amended in claim 8, Applicant has replaced the term “a card receiver” with “a card reader.”

With respect to claims 23, 26 and 27, since they are dependent from claim 21, these claims should be allowed if claim 21 is allowed. Additionally, since claim 26 requires “recording, internally within the machine, a transaction record of the transfer” which is not taught by Konya, this claim should be allowed whether or not it is dependent from claim 21. Additionally, Applicant has amended claim 26 by deleting the limitation of “internally within the machine” as it appears to be unduly limited.

For at least these reasons, Applicant respectfully submits that these claim rejections should be reconsidered and withdrawn.

Claim Rejections under 35 U.S.C. § 103

The Examiner further rejected dependent claims 9, 11, 12, 15, 22, 24, 25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Konya in view of Bator et al. (U.S. Patent No. 6,575,362, hereinafter as “Bator”). Applicant respectfully traverses this rejection.

These rejected claims are dependent from claim 8 or claim 21. Thus, these claims should be allowed if independent claims 8 and 21 are allowed.

Additionally, with respect to claim 9, the Examiner admitted that Konya does not teach a cash receiver (and the feature of a cash acceptor is incorporated into independent claim 8). The Examiner alleged that Bator teaches a cash receiver and that it would have been obvious to combine this feature with the disclosure of Konya. Applicant submits that Bator is drawn to a stand-alone device (see column 1, lines 11-16) and in contrast to a method and automated banking system for receiving payment from a user and for transfer of funds to a transferee in a network. The system as described in Bator is geared towards a method and apparatus for generating and issuing financial instruments such as money orders and similar negotiable instruments (column 1, lines 5-8). As such, Bator’s system and method pertain to providing security labels for these financial instruments (column 8, lines 43-53) and Bator’s objective and environment for such is different from the transfer of funds of the present invention. Thus, it would not have been obvious to combine the

teaching of Bator to those of Konya as alleged by the Examiner.

Additionally, with regard to claim 22, the Examiner alleged that Bator discloses “depositing cash for the wire transfer; counting the cash received in the machine; and verifying it as being an amount to cover the wire transferred amount” referring to the disclosure of Bator at column 9, lines 60-67 which state “the requested money order is only issued after a sufficient amount of actual money is deposited in the kiosk via a bill acceptor.” As the Examiner indicated, this passage only describes that if the user does not deposit the sufficient amount of money, the machine will not issue the money order. Applicant submits that this passage does not expressly teach the detailed steps of “counting the cash” and “verifying it as being an amount to cover the transferred amount,” and thus claim 22 should be allowable regardless of the claim dependency.

For at least these reasons, Applicant respectfully submits that these claim rejections should be reconsidered and withdrawn.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with

or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Should the Examiner have any questions or comments regarding this matter, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,
Dennis G. THIBEDEAU et al.



Abraham HersHKovitz
Reg. No. 45,294
Dinh X. Nguyen
Reg. No. 54,923
Jae Youn Kim
L0485

October 23, 2008

HERSHKOVITZ & ASSOCIATES, LLC
2845 DUKE STREET
ALEXANDRIA, VA 22314

(703) 370-4800
(703) 370-4809 (FAX)

AH/DXN/SK